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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,957	12/07/2001	Carol J. Nikolaus	076565-0119	5680
26371	7590	07/22/2004	EXAMINER	
FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			SMALLEY, JAMES N	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/010,957

Applicant(s)

NIKOLAUS ET AL.

Examiner

James N Smalley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31,37-50,52-54,58-65,75-86 and 88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31,37-50,52-54,58-65, 75-86 and 88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Examiner acknowledges the Applicant's intention to cancel claims 51, 55-57 and 87. See Remarks, 27 April 2004, page 16, second-to-last line, and continuing through lines 1-2 on page 17. Examiner notes claim 87 has been canceled, however, claims 51 and 55-57 are still marked "Previously Presented" in the Listing of the Claims, also 27 April 2004.

To cancel these claims, the reply to this Action must mark claims 51 and 55-57 canceled.

### ***Drawings***

2. The drawings cancellation of figs. 8a and 8b was received on 27 April 2004. These drawing deletions are accepted.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 19-22, 37-50, 52-54, 58-65, 75-79, 83-86 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okojima et al. US 4,799,604 in view of Leung US 6,178,085.

Okojima '604 teaches a vanity case, having a spring and coupling the cover to the base, and configured for pivoting the cover from a closed to open position and revealing a cosmetic, whereby a spring is tensioned when the cover is in the closed position and partially relaxed in the open position. In col. 3, lines 34-35, Okojima '604 teaches the tray (16) holds a cosmetic material.

Okojima '604 does not teach a damper assembly coupled to the hinge assembly.

Leung '085 teaches a calculator having a hinged cover biased to an open position by a coil spring (62), and further coupled with a damper assembly. Leung '085 teaches the purpose of the damper

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assembly is to, "slow down and counteract any tendency for rapid pivoting movement of the lid structure which could conceivably cause the calculator to bounce..." (col. 5, lines 49-51).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the vanity case hinge assembly of Okojima '604, providing an a damper to the assembly as taught by Leung '085, motivated by the benefit of counteracting rapid pivoting movement of the lid during the opening operation.

Regarding the configuration of the damper assembly to limit pivoting of the cover at a rate of about 60 to 120 degrees per second, Examiner notes Leung '085, col. 5, lines 44-49, teaching: "The rate of movement or speed in the rearward pivoting of the lid structure (14) upon release thereof is controlled by means of the damping drum (70) and the damping grease (84) arranged thereabout in contact with the inner surface of the blind bore (40) which, in essence, forms a damping cylinder." Leung '085 clearly discloses the mechanisms which are responsible for controlling the opening rate. One having ordinary skill would find it obvious to configure the assembly to meet any desired opening rate range.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the damping cylinder assembly, allowing the cover to open at a desired rate including between 60 to 120 degrees per second, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

5. Claims 6-18, 23-31 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okojima et al. US 4,799,604 in view of Leung US 6,178,085 as applied to claim 22 above, and further in view of Taniyama US 5,213,229.

Okojima '604 does not disclose a detent coupled to the cover or base to limit the range the cover pivots from the closed position to the open position.

Taniyama '229 discloses a motion limiting mechanism for storage containers, comprising an arcuate slot (63') disposed on a container and a protrusion (62') disposed on a cover, for limiting the opening range of the cover. It is further disclosed, in col. 2, lines 17-20, that the arc of the arcuate slot

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may be enlarged or decreased, so as to vary the range of motion of the cover from within 0 to 360 degrees.

It would have been obvious to add an arcuate slot to the base component, and a limiting protrusion to the cover, as taught by Taniyama '229, motivated by the benefit of customizing the opening angle of the cover. Such a modification would be desirable, for example to provide an ideal angle between a user's eye level, and the face of the mirror (18) of Okojima '604.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-5, 42-44, 48-50, 52, 75-79, 83-85 and 88 under 35 USC 102(b) over Okojima '604 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments with respect to claims 8 and 82 under 35 USC 103(a) over Okojima '604 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed 27 April 2004 regarding the rejection of claims 19-22, 37-41, 45-47, 53-54, 58-65 and 86 under 35 USC 103(a) over Okojima '604 in view of Leung '805 have been fully considered but they are not persuasive.

### **Applicant asserts a prima facie case of obviousness has not been established.**

Examiner contends the motivation to combine Okojima '604 and Leung '805 is, in fact, present. The benefit to the damping mechanism suggested by Leung '805, in col. 5, lines 49-53, is to, "slow down and counteract any tendency for rapid pivoting movement of the lid structure which could conceivably cause the calculator to bounce and possibly damage the delicate internal components or electronics thereof." The benefit is stated up front in the passage; "to slow down and counteract any tendency for rapid pivoting movement of the lid structure..." The rest of the passage begins, "which could conceivably..." indicating that Leung is now speculating on a possible benefit within the context of the reference on which it is applied. One having ordinary skill would understand the teaching to be a

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particular, specific application of a broader benefit, that being to slow down or counteract any tendency for rapid pivoting movement of spring biased hinge assemblies.

Okojima '604 teaches, in col. 3, lines 34-35, that the tray (16) contains a cosmetic material. Cosmetic materials are delicate, such as powders, and are generally provided with an application brush and even mirrors (18). Further, Okojima '604 is opened by a coil-spring-biased hinge assembly. One having ordinary skill would recognize that rapid opening movement of the case, by the biasing of the spring on the hinge, could damage the mirror, or dislodge the applicator or actual cosmetic material, and a damping mechanism would be suitable to prevent such unfavorable outcomes.

Regarding the configuration of the pivoting rate, Examiner cites Eromaki US 6,510,588, disclosing a viscous damping mechanism comprising a torsion spring hinge assembly, and teaching in col. 4, lines 56-66, "Thus, the speed of the opening motion can be adjusted to meet the requirements set by any given application, and the speed of the turning motion can be adjusted as desired." This passage supports the Examiner's assertion that it would have been obvious to configure the damping assembly of Leung '085, applied to the Vanity Case of Okojima '604, to open at any desired rate.

**Applicant asserts Okojima '604 does not teach a cosmetic.**

Okojima '604 teaches in col. 3, lines 34-35, "a tray (16) for containing *cosmetic material* is housed within the receptacle (10)..." Examiner contends the vanity case of Okojima '604 teaches a cosmetic. Further, the Applicant contends Okojima '604, "would require still further modification, and such modification is taught only by the Applicant's own disclosure. Examiner contends that all *claimed* limitations are met by the teachings of Okojima '604 in view of Leung '085, and that hindsight reasoning has not been employed.

**Applicant asserts Leung '085 is nonanalogous art.**

Examiner asserts Leung '085 is, in fact, quite analogous to the teaching of Okojima '604. The Examiner contends that one having ordinary skill would recognize that Leung '085 and Okojima '604 both teach coil-spring-biased hinge closing lids or covers. One having ordinary skill need not consider the function of an entire device, but instead, is capable of isolating the individual functioning elements that combine to make the device. Ordinary skill allows one to recognize the benefit in one of

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these isolated features (e.g., a spring-biased hinge assembly, or a spring-biased hinge assembly further coupled with a damping mechanism to limit the pivoting rate), and apply them to other systems. The fact that the calculator contains electronic parts, and is sold in different channels of commerce does not blind one having ordinary skill to the fact that both teach coil-spring-biased hinge assemblies.

Further, it has been recognized that a person having ordinary skill in the art is presumed to have knowledge of all of the relevant prior art in his field of endeavor, as if it were all hanging on his workshop walls. *Filmon Process Corp. v. Spellright Corp.*, 274 F. Supp. 312, 313, 155 USPQ 635, 636 (D.D.C. 1967), *aff'd*, 404 F.2nd 1351, 131 U.S. App. D.C. 374, 158 USPQ 533 (1968).

9. Applicant's arguments with respect to claims 23-31 under 35 USC 103(a) over Okojima '604 in view of Leung '085 and in further view of Taniyama '229 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments with respect to claims 6-7 and 80-81 under 35 USC 103(a) over Okojima '604 in view of Taniyama '229 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments with respect to claims 9-18 under 35 USC 103(a) over Okojima '604 in view of Taniyama '229 and in further view of Leung '085 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

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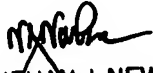
shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N Smalley whose telephone number is (703) 605-4670. The examiner can normally be reached on M-Th 9-7:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (703) 308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns

  
NATHAN J. NEWHOUSE  
PRIMARY EXAMINER  
7/21/04